

**REMARKS**

In the Office Action the Examiner noted that claims 1-10 are pending in the application. The Examiner rejected claims 1 and 5-10, and objected to claims 2-4. By this Amendment, claims 1, 3, 5, 7-9, and 10 have been amended. No new matter has been presented. Thus, claims 1-10 remain pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

**Claim Rejections Under 35 USC §102**

On page 2 of the Office Action the Examiner rejected claim 10 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0032613, issued to Buettgenbach et al. (hereinafter referred to as "Buettgenbach"). The Applicants respectfully traverse the Examiner's rejection of claim 10.

Claim 10 of the present application recites accepting delivery terms "entered by a prospective recipient of the item after the item has been ordered; wherein said delivery terms comprise a date and time of delivery." The Applicants respectfully submit that Buettgenbach does not disclose or suggest at least these features of claim 1.

Buettgenbach discloses allowing a recipient to designate a community pickup center as a destination for an item to be delivered, so that the recipient does not have to be home to receive it, or worry about the safety of the item. As the item is allowed to stay at the pickup center indefinitely until the recipient picks the item up in Buettgenbach (Paragraph [0049]), there is no consideration whatsoever regarding date and time when delivery terms are being determined (the delivery terms in Buettgenbach merely involving the designation of the pickup center).

Therefore, Buettgenbach does not disclose at least the feature of accepting delivery terms "entered by a prospective recipient of the item after the item has been ordered; wherein said delivery terms comprise a date and time of delivery." Accordingly, Buettgenbach does not disclose every element of the Applicants' claim 1. In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since Buettgenbach does not disclose the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over Buettgenbach, and withdrawal of the §102(e) rejection is earnestly and respectfully solicited.

Claim Rejections Under 35 USC §103

On pages 3-6 of the Office Action the Examiner rejected claims 1 and 6 under 35 U.S.C. §103(a) as being unpatentable over Buettgenbach "in view of official notice," and rejected claim 7 as being unpatentable over Buettgenbach. The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 1 of the present application, as amended, recites a method for managing delivery of product that have been ordered wherein a delivery recipient designates delivery terms, and "wherein the delivery terms comprise a date and time of delivery."

As discussed in the previous section of this Amendment, Buettgenbach does not disclose or suggest the feature of the designated delivery terms comprising a date and time of delivery. In Buettgenbach, the delivery recipient is notified by the community pickup center when the package has arrived, as opposed to the delivery recipient designating the date and time of delivery.

Further, claim 1 of the present application, as amended, also recites "presenting a screen which accepts delivery applications of the products to a provider of the products, and accepting applications on the screen for delivery of said products from the provider of said products." In other words, the product provider is presented a delivery application which is used to request delivery of an ordered product. These applications are assigned ID's which are used to allow a recipient to designate delivery terms for the ordered products. The Applicants respectfully submit that Buettgenbach also does not disclose or suggest at least these features of claim 1.

Buettgenbach discloses a method of delivering products ordered from a vendor that avoids the typical home delivery problems of excessive cost, risk, and inconvenience (Paragraph [0006]). The method includes ordering goods from vendors that are associated with pickup centers, or will-call centers, that are established in relatively high-traffic locations such as employment sites, apartment buildings, universities, gated communities, and retail locations (Paragraph [0031]). In other words, the delivery is made to a publicly used place other than the private residence of the buyer.

The buyer in Buettgenbach places an order with a vendor, and designates the pickup center and identifies a recipient (Paragraph [0038]). The Examiner has apparently characterized the designation of the pickup center and the recipient identification as "delivery terms." The

vendor then processes the order and ships the order as a delivery to the pickup center using any appropriate shipping method (Paragraph [0047]). The vendor notifies the pickup center that the order has been shipped and that delivery through that pickup center has been specified (Paragraph [0048]). In other words, the vendor must make all the shipping arrangements to the pickup center, as per the conventional method.

This is in direct contrast with the features recited in claim 1 of the present application. While the Examiner stated that Figure 1 (as well as Paragraphs [0031], [0037], and [0038]) of Buettgenbach discloses a screen which accepts applications for delivery of said products from a provider of said products, the Applicants respectfully submit that Figure 1, and the method discussed in the cited paragraphs, clearly indicates that the screen is presented to the buyer, and is used to identify vendors that are associated with a particular pickup center. After contacting one of the associated vendors to order the product, and subsequently ordering the product, the vendor then handles delivery of the product to the designated pickup center by conventional shipping choices and methods in Buettgenbach. However, with the method claimed in claim 1 of the present application, the product provider can simply apply for delivery of the product, and the buyer can then designate delivery terms according to the buyer's preferences after ordering the product, based on the delivery application, without the product provider being involved. This both increases the convenience of the user, which can designate convenient delivery terms, and for the product provider, who is removed from the delivery term determination process.

Therefore, the Applicants respectfully submit that Buettgenbach does not disclose, suggest, or even contemplate at least the features of a delivery recipient designating delivery terms, "wherein the delivery terms comprise a date and time of delivery", or "presenting a screen which accepts delivery applications of the products to a provider of the products, and accepting applications on the screen for delivery of said products from the provider of said products," as is recited in claim 1 of the present application. Further, the deficiencies of Buettgenbach are not cured by any Official Notice taken by the Examiner. Therefore, as at least these features of claim 1 are not disclosed or suggested by Buettgenbach, the Applicants respectfully submit that claim 1 patentably distinguishes over Buettgenbach, and requests the withdrawal of the Examiner's §103 rejection.

Claim 6 depends from claim 1 and includes all of the features of that claim plus additional features which are not disclosed or suggested by the cited references. Therefore, it is respectfully submitted that claim 6 also patentably distinguishes over the cited references.

Claim 7 of the present application recites a delivery management device which manages delivery of order products, and recites different means for performing various functions. The Examiner apparently based the §103 rejection of claim 7 on his reasoning for rejecting claim 1. However, it is apparent from the language of claim 7 that all of the recited means are parts of the same entity, which is not disclosed or suggested in Buettgenbach. For example, the operation which the Examiner characterized as assigning application ID's in Buettgenbach is performed by the pickup center (Paragraph [0049]). Also, the operation which the Examiner characterized as prompting a recipient to designate delivery terms is performed by the vendor. The vendor and the pickup center in Buettgenbach are obviously different entities.

Also, claim 7, as amended, recites "means for accepting applications from a provider of products for delivery of said products" and "the delivery terms comprise a date and time for delivery." As discussed in regard to claim 1 of the present application, Buettgenbach does not disclose or suggest at least these features of claim 7. Therefore, it is respectfully submitted that claim 7 also patentably distinguishes over the cited references.

In response to the Examiner's statement regarding the "means for" language of claim 7, the claim has been amended so as to be placed in better form. Therefore, the Applicants assume that no statement is required invoking 35 U.S.C. §112, sixth paragraph.

On page 5 of the Office Action the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Buettgenbach and "official notice" as applied to claim 1, and further in view of U.S. Patent No. 5,732,400, issued to Mandler (hereinafter referred to as "Mandler"). The Applicants respectfully traverse the Examiner's rejection of claim 5.

As Mandler apparently merely discloses notifying a product provider that products have been purchased, the Applicants respectfully submit that Mandler does not cure the deficiencies of Buettgenbach in regard to claim 1 of the present application. Therefore, as claim 5 depends from claim 1 and includes all of the features of that claim plus additional features which are not disclosed or suggested by the cited references, it is respectfully submitted that claim 5 also patentably distinguishes over the cited references.

Further, the Applicants respectfully submit that there is no motivation to combine Buettgenbach and Mandler. The Examiner stated that "it would have been obvious to one of ordinary skill in the art....to notify the provider as claimed, for the obvious advantage, as taught in Mandler, of arranging for the shipping and delivery of ordered products." However, the Applicants respectfully submit that this is not a reasonable statement, the original order in the method of Buettgenbach is placed through the product provider. Further, in Buettgenbach the

shipping and delivery is arranged by the product provider before the pickup center is notified (Paragraphs [0047]-[0048]). Therefore, the reasoning provided by the Examiner is counterintuitive, and Buettgenbach actually teaches away from the combination.

On pages 6-8 of the Office Action the Examiner rejected claims 8-9 as being unpatentable over Buettgenbach in view of U.S. Patent No. 5,960,411, issued to Hartman et al. (hereinafter referred to as "Hartman") and U.S. Patent No. 5,862,223, issued to Walker et al. (hereinafter referred to as "Walker"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claims 8 and 9 each recite using date and time as delivery terms input by the recipient. As previously explained, Buettgenbach proposes a method in which deliveries are made to a community pickup center, and was expressly developed to avoid the problems of date and time of delivery. In other words, the date and time information is not considered at all, whereas the date and time information is instrumental in the method of the present application. Therefore, neither Buettgenbach, Hartman, nor Walker, either alone or in combination, disclose or suggest at least this feature of claims 8 and 9.

Also, there is no teaching in Buettgenbach that would suggest combination with Hartman or Walker. The Examiner acknowledged that Buettgenbach does not disclose or suggest a plurality of features recited in claims 8-9, but indicated that those deficiencies are cured by Hartman and Walker. The Applicants respectfully submit that, even assuming, arguendo, that the cited features were disclosed by Hartman and Walker, there is absolutely no motivation to combine the references.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that it would have been obvious to combine Buettgenbach with Walker to provide for referring to an address table and extracting the notification of the delivery recipient. The Examiner stated that it would have been obvious "to refer to an address table and extract the notification address therefrom, for the obvious advantage of delivering the article or articles to the correct address." The Applicants respectfully submit that this is an unreasonable statement, as the entire purpose of Buettgenbach is to avoid sending the products to the address of the delivery recipient, and therefore teaches away from any such provision. The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317

(Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” Dembiczak, 50 USPQ2d at 1617. “The factual inquiry whether to combine the references must be thorough and searching.” In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

While the Examiner may be attempting to characterize the pickup center itself as the delivery recipient in the rejection based on Buettgenbach and Walker, it is apparent from the recited language of claims 8-9 that the delivery recipient provides the delivery terms. This would equate with the pickup center of Buettgenbach providing the delivery terms, which is not a reasonable interpretation.

Further, Buettgenbach also teaches away from any combination with Hartman, which the Examiner stated would provide the advantage of minimizing shipping cost and purchaser confusion, or the obvious advantage of arranging for delivery recipients to make fewer trips to pick up available goods at the pickup center. There could be no purchaser confusion in Buettgenbach, because the recipient is merely notified when the package has arrived, and no confusion is possible as to which package it is. Also, there would be no logical reason for the recipient to make multiple trips to the pickup center, when he/she could merely wait until all the packages are there before picking them up. The Examiner seems to be taking the position that the recipient must pick the package up immediately, but the purpose of Buettgenbach is to allow the package to comfortably remain until the recipient has occasion to pick it up (Paragraph [0049]).

Thus, the Applicants respectfully submit that there is no motivation to combine either Walker or Hartman with Buettgenbach, and certainly no reason to combine all three. Even further, neither Walker nor Hartman cure the discussed deficiencies of Buettgenbach even if they were combined. Therefore, the Applicants respectfully submit that claims 8 and 9 patentably distinguish over the cited references.

#### Summary

Serial No. 09/769,533

In accordance with the foregoing, claims 1, 3, 5, 7-9, and 10 have been amended. No new matter has been presented. Claims 1-10 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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